

REMARKS

Claims 1-21, 25 and 26 are in the application. Claims 22, 23, 24 and 27-34 have been canceled as directed to a non-elected invention. These claims are canceled without prejudice to Applicant's right to file divisional applications thereon. It is noted that the examiner withdrew claims 5 and 10-14. However, these claims were initially included in Group I, the elected invention. It is assumed that the examiner withdrew these claims because they do not read on the elected species. However, claims 5 and 10-14 are properly examinable unless no generic claim is ultimately held allowable. As presented below, it is submitted that the generic claims within Group I are allowable, therefore claims 5 and 10-14 are properly examinable and should not be held to be withdrawn as non-elected.

Claims 18, 20, 25 and 26 have been amended. No claim is allowed.

Claims 25 and 26 have been objected to under 37 C.F.R. 1.75(c) as being in improper form of a multiple dependent claim. These claims have now been amended to an accepted format as shown in MPEP 608.01(n). Withdrawal of the objection is respectfully requested.

Claims 1-4, 6, 8, 9, 15-21, 25 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in the phrases "their derivatives, their analogs", "a derivative thereof", and "or their derivatives". This rejection is respectfully traversed. The examiner alleges that it is unclear what constitutes a derivative and/or analog. However, the examiner is invited to review the definitions of the terms "analog" and "derivative" set forth in the specification on page 12. It is submitted that this clearly sets forth the metes and bounds of the terms and that the claims thus comply with 35 U.S.C. 112, second paragraph. It is respectfully requested that this rejection be withdrawn.

Claims 1-4, 6, 8, 9, 15, 16, 18, 19, 20, 21, 25, and 26 are rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Nag, et al., U.S. 6,794,401, hereafter "Nag". This rejection is respectfully traversed. Specifically, the examiner cites the compound in column 51, example 1 of the reference. However, the examiner's attention is directed to the substituent on the left side of that formula in column 51 of Nag that occurs on the phenyl ring. To the far left of that formula, the substituent does not come within the definition of the substituent C₂-C₁-B-A- in the present Formula I. In particular, in Formula I, C₂ and C₁ are both amino acids. In the formula in column 51 of Nag, there is only a single amino acid present. Therefore, the formula cited in column 51 does not anticipate the present claims. There are no other compounds disclosed in Nag which come within the formula defined in Formula I of the present application. Accordingly, it is respectfully requested that this rejection be withdrawn.

Claims 1-4, 6, 8, 9, 25, and 26 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Fujita, et al., U.S. 6,562,849, hereafter, "Fujita." This rejection is respectfully traversed. Specifically, the examiner cites the compounds shown in columns 65 and 66 and in

columns 77 and 78 of the reference. Again, looking to the substituent in these compounds in the reference which are on the left of the phenyl ring, the substituents do not fall within the definition of the substituent C₂-C₁-B-A- in Formula I of the present application. In particular, for example, in Formula I of the present application, there is a requirement that there be a C₂-C₁ moiety, which are two amino acids joined together by an amide bond. No such moiety exists in the substituents on the phenyl ring in Fujita. Accordingly, it is respectfully submitted that this reference does not anticipate the present claims and withdrawal of the rejection is requested.

Claims 1-4, 6, 8, 9, 25 and 26 are rejected under 35 U.S.C. 102(b) as being allegedly anticipated by Sohda et al., U.S. 6,552,058, hereafter "Sohda." This rejection is respectfully traversed. The examiner cites columns 1-4 of the reference. In the formulas in those columns the left hand substituent on the phenyl ring is described as R-(Y)_m-(CH₂)_n-CHR¹-O-. In Sohda the component Y can be a -CO- or NR₃, which means there can be only a carbonyl or an amine in the entire substituent. Thus, there cannot be an amino acid in that substituent, much less two amino acids. Therefore, the substituent described above in Sohda does not fall within the scope of C₂-C₁-B-A- in Formula I of the present application. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 1-4, 6, 8, 9-15-21, 25 and 26 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Nag. This rejection is respectfully traversed.

The examiner alleges that Nag teaches derivatives or analogs and/or processes or preparation of the claimed dipeptide phenyl ethers of the present Formula I. This rejection is respectfully traversed. Nag does not teach analogs of the compounds according to the present Formula I. According to the common chemical definition of "analog" which is consistent with Applicant's definition set forth on page 12 of the present application, an analog is one in which two compounds differ only by replacement by one or more heteroatoms. The compounds of Formula I contain at least an additional amino acid, C₁, which is not obtained by merely replacing one or more heteroatoms into formulas described by Nag, the presently claimed compounds are not analogs of those disclosed in Nag. Neither are the present compound derivatives of those described in Nag. As discussed on page 12 of the present specification, a derivative refers to a compound obtained from another compound by simple chemical process, such as by an oxidation or an acylation. However, one cannot obtain the class of compounds of the present Formula I by a simple chemical process from the single amino acid containing compounds in Nag. Not only is there a possibility of interference from other functionalities in substituents R₁, R₂, R₃ and R₄ in Nag's Formula I, but the possible side chains on X itself are possible interfering functionalities. Therefore, it is submitted that the class of compounds of Applicant's Formula I are not derivatives of Nag's compounds of the Formula I.

The examiner further states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust particular conventional working conditions within the synthetic method of Nag by using different paths and/or protecting groups. This point is also respectfully traversed. The examiner fails to cite the motivation for making compounds according to present Formula I. Among the many possible ways to modify the compounds of Formula I in Nag, where is the teaching that one should only modify at the site of moiety X? And where is the motivation that the site at X should be modified only by adding an alpha amino acid? There is no teaching in Nag to motivate one of ordinary skill in the art to make such modifications.


Accordingly, it is submitted that the present claims are unobvious over Nag and reconsideration and withdrawal of the rejection are respectfully requested.

Claims 1-4, 6, 8, 9, 15, 16, 18, 19, 20, 21, and 26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14, 16-23 of Nag. Applicants enclose an executed Terminal Disclaimer that obviates this rejection. Accordingly, withdrawal of this rejection is respectfully requested.

For the foregoing reasons it is submitted that this application is in condition for allowance.

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Respectfully submitted,
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